UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,711	07/16/2003	Weiling Peng	129843.1071 (H.063A)	9592

60148 7590 07/22/2008

GARDERE / JAMES HARDIE
GARDERE WYNNE SEWELL, LLP
1601 ELM STREET
SUITE 3000
DALLAS, TX 75201

EXAMINER	
GILBERT, WILLIAM V	

ART UNIT	PAPER NUMBER
3635	

MAIL DATE	DELIVERY MODE
07/22/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/620,711	PENG, WEILING	
	Examiner	Art Unit	
	William V. Gilbert	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-14 and 18-79* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-22, 71-79* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This is a First Action following a Request for Continued Examination. Claims 1-8 and 15-17 are cancelled. Claims 9-14 and 18-79 are pending. Claims 9-14 and 23-70 are withdrawn from consideration. Claims 18-22 and 71-79 are examined.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 April 2008 has been entered.

Claim Objections

2. **Claim 21** is objected to because of the following informalities: applicant uses the limitation “and/or” (line 3), which is unclear to the examiner as to whether applicant intends for the stacking to be "front-to-front **and** back-to-back" or “front-to-front **or** back-to-back”, and the limitation should be

amended to reflect one or the other. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 18-22 and 71-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss (U.S. Patent No. 6,949,160) in view of Youssi (U.S. Patent No. 3,358,355)

Claim 18: Weiss discloses a plurality of fiber cement products (Col. 3, lines 39-42) arranged in a stack (Abstract: lines 3-7) comprising a non-adhesive finish layer (Fig. 1: 16, it is paint), applied to the product and a protective layer (22) adhered to the finished layer, the protective layer protects the finish layer from damage in storage, removing the protective layer leaves no residue on the finish (Col. 10, lines 8-15), and the layer resists tearing on removal (it is inherent that the coating resists tearing on removal; Col. 13, lines 40-50). Weiss does not disclose that the protective layer has a separate adhesive layer. Youssi discloses a panel (10) with a removable layer (19) that has a multi layer comprising an adhesive layer (see Col. 3, lines 40-75 where the film is heat bonded to the panel. The heat would form the adhesive layer from the material and the exterior surface of the film would form a second layer. See also Col. 3, lines 65-70 where strippable adhesives may also be used.) Further, the layer does not damage the finish layer (Col. 3, lines 65, 66) and resists tearing on removal (Col. 3, lines 74, 75.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the covering in Youssi with the panel in Weiss because the coverings are functionally equivalent and would perform equally as well with each other.

Claim 19: while Weiss in view of Youssi discloses that the products are stacked (Fol. 3, line 40), it does not disclose that the products are arranged on a pallet. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to stack the products on a pallet because it is well known in the art to stack such products on pallets to ease in transportation and storage.

Claims 20 and 21: Weiss in view of Youssi discloses the claimed invention except for the orientation of the stacked products. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to stack the materials in the manner in the claims because since a protective coating is on the material, the aesthetic surface will not suffer damage from placing a product on top of it.

Claim 22: the products are banded together (Weiss: Col. 3, lines 42-44).

Claim 71: Weiss discloses a pre-finished fiber cement product comprising a fiber cement article (Col. 3, lines 39-42) that has a non-adhesive finish layer (Fig. 1: 16, it is paint) applied to the product and a film adhered to the finished layer, the film is selectively removable (Col. 13, lines 40-50), and no residue is left on the panel (Col. 1, lines 8-15). Weiss does not disclose that the adhesive layer is adhered to the finish

layer by a separate adhesive layer. Youssi discloses a panel (10) with a removable layer (19) that has a multi layer comprising an adhesive layer (see Col. 3, lines 40-75 where the film is heat bonded to the panel. The heat would form the adhesive layer from the material and the exterior surface of the film would form a second layer. See also Col. 3, lines 65-70 where strippable adhesives may also be used.) Further, the layer does not damage the finish layer (Col. 3, lines 65, 66.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the covering in Youssi with the panel in Weiss because the coverings are functionally equivalent and would perform equally as well with each other.

Claim 72: the film is polyethylene, which is a copolymer.

Claim 73: while the prior art of record does not disclose specifically that the adhesive is ethylene acrylic acid, the prior art does disclose that adhesives can be used (Youssi: Col. 3, lines 65-75.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the adhesive as ethylene acrylic acid as a matter of functional equivalence that would perform equally as well as applicant notes that these resins are known in the art

(Specification page 7, paragraph 0036), and Youssi discloses that other materials may be used as the protective film.

Claims 74-76: the film is a polyethylene (Youssi: Col. 3, lines 45-50 which is a polymer,) and the disclosure notes that heat treatment is used to bond the film to the outer layer of the panel, which would result in the polyethylene to have a resinous texture.

Claims 77-79: while Weiss discloses the limitations as claimed for the thickness of the protective layer, Youssi is silent regarding this limitation. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV)(A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Response to Arguments

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection as the applicant amended the claims.

Regarding the combination of the references, the examiner used the rationale that the Weiss reference provided a board with a finish layer and a removable protective film on it. The process and apparatus for application of the film were not considered. As noted, however, the Weiss reference did not provide the limitations to the protective film, which was the purpose of the secondary reference. The second references used serve the same purpose as the film in Weiss: to provide a removable protective cover for an article. The examiner concluded that the result would be predictable by substituting one protective covering for another because the function and the purpose is the same.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./
Examiner, Art Unit 3635
/Basil Katcheves/
Primary Examiner, Art Unit 3635